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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,236	07/31/2001	Norman Yamamoto	081400-003	5853
21836 7590 02/23/2007 HENRICKS SLAVIN AND HOLMES LLP SUITE 200 840 APOLLO STREET EL SEGUNDO, CA 90245			EXAMINER AHMAD, NASSER	
			ART UNIT 1772	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/23/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 09/920,236	Applicant(s) YAMAMOTO, NORMAN	
	Examiner Nasser Ahmad	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 15, 17 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 15, 17 and 20-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Appeal Brief

1. The finality of the last Office Action of 3/24/2006 has been withdrawn in view of the newly uncovered prior art reference of Kroll (US Patent 6578499), Phillips (US Patent 6464821) and Rudin (US Patent 6187405).

A complete Action on the merit follows:

Rejections Withdrawn

2. Claims 1-11 and 20-22 are rejected under 35 U.S.C. 112, first paragraph, made in the last Office Action of 3/24/2006 has been withdrawn in view of the Appeal Brief filed on 10/23/2006.

3. Claims 1-11 and 20-22 are rejected under 35 U.S.C. 112, first paragraph, made in the last Office Action of 3/24/2006 has been withdrawn in view of the Appeal Brief filed on 10/23/2006.

4. Claims 14 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Boudet (3950580) made in the Office Action of 9/30/2005 and maintained in the Office Action of 3/24/2006 has been withdrawn in view of the Appeal Brief.

5. Claim 24, is rejected under 35 U.S.C. 103(a) as being unpatentable over Boudet made in the Office Action of 9/30/2005 and maintained in the Office Action of 3/24/2006 has been withdrawn in view of the Appeal Brief.

Allowable Subject Matter Withdrawn

6. Claims 15, 17 and 25-26 indicated as being allowable in the Office Action of 3/24/2006 is withdrawn in view of the newly uncovered prior arts.

Response to Arguments

7. Applicant's arguments with respect to claims 1-12, 14-15, 17, 20-26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-2, 4-6, 8, 9-10, 12, 14, 20-21, 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Kroll (US006578499B2).

Kroll relates to an article (figure-7) comprising an at least substantially opaque sheet (90, wherein the material can be paper, col. 2, lines 31-32, which is known to be substantially opaque) defining a front side, a rear side and a plurality of side edges; at least one strip of adhesive material (92) on one of the front and rear sides of the at least substantially opaque sheet adjacent to a first one of the plurality of side edges; and a

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plurality of liners (col. 2, line 22) positioned over the at least one strip of adhesive material and adjacent to the first one of the plurality of side edges with one of the plurality of liners located between the first one of the plurality of side edges and another one of the plurality of liners (figure-7 shows two strips and one of the strip is located between an edge of the sheet and the other strip).

The preamble phrase "printable media" is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause.

For claim 2, the at least substantially opaque sheet comprises a paper sheet (col. 2, lines 31-32).

For claim 4, the adhesive material comprises pressure sensitive adhesive because the adhesive is covered with a release, which is a well known characteristics of a pressure sensitive adhesive.

Regarding claim 5, a second one of the side edges is parallel to the first one of the side edges (figure-1) and the at least one strip of adhesive material extends only partially from the first one of the side edges to the second one of the side edges (figure-1 shows that the adhesive extends only from a first side edge to the second side edge).

For claim 6, the at least one strip of adhesive material comprises a plurality of strips of adhesive material and the plurality of liners are respectively positioned over the plurality of strips of adhesive material (figure-7 and col. 2, line 22 showing a plurality of adhesive strips and each of the adhesive strips being covered by a release liner).

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As for claim 8, the side edges define longitudinal ends and the adhesive material extends substantially from one longitudinal end of the one of the plurality of side edges to the other longitudinal end of the one of the plurality of side edges (figure-1 shows that the adhesive strip extends substantially from one end to the other end of the longitudinal side edges).

Regarding claim 9, Kroll relates to an article (figure-1) comprising an at least substantially opaque sheet (10) defining a front side, a rear side and at least first and second intersecting side edges, each of the first and second side edges defining opposing longitudinal ends, one of longitudinal ends of each of the first and second side edges defining a common longitudinal end (figure-1, upper left hand corner); a substantially continuous first strip of adhesive material (12 is a substantially continuous adhesive material) on one of the front and rear sides of the at least substantially opaque sheet adjacent to the first side edge and extending substantially from one longitudinal end of the first side edge to the other longitudinal end of the first side edge; and a substantially continuous second strip of adhesive material (the second strip shown as intersecting the first strip) on the one of the front and rear sides of the at least substantially opaque sheet adjacent to the second side edge and extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge.

As for the preamble phrase "A printable media", the explanation is provided hereinabove as why it is not found to be a limitation.

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For claim 10, the at least substantially opaque sheet comprises a paper sheet (col. 2, lines 31-32).

For claim 12, the adhesive material comprises pressure sensitive adhesive (see explanation provide for claim 4).

As for claim 14, the article in figure-7 shows a sheet defining a front side, a rear side and at least first and second intersecting side edges, each of the first and second side edges defining opposing longitudinal ends, one of longitudinal ends of each of the first and second side edges defining a common longitudinal end; a plurality of first strips of adhesive material (provided along one side edge of the sheet in figure-7) on one of the front and rear sides of the sheet adjacent to the first side edge and extending substantially from one longitudinal end of the first side edge to the other longitudinal end of the first side edge; a plurality of second strips of adhesive material (provided along the second side edge in figure-7) on the one of the front and rear sides of the sheet adjacent to the second side edge and extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge; a plurality of first liners respectively positioned over the plurality of first strips of adhesive material; and a plurality of second liners respectively positioned over the plurality of second strips of adhesive material (the adhesive material strips are covered by respective release liners as mentioned in col. 2, line 22).

The preamble phrase has not been given any patentable weight as explained hereinabove.

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For claim 20, it is shown in figure-1 wherein the adhesive strips are covered by respective liners along intersecting edges.

For claims 21 and 23, see explanation provide hereinabove in claim 2.

10. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Phillips (US006464821B1).

Phillips relates to an article (figure-1) comprising an at least substantially opaque sheet (col. 3, lines 11-15) defining a front side, a rear side and a plurality of side edges; a single strip of adhesive material (22) defining a width on one of the front and rear sides of the at least substantially opaque sheet adjacent to a first one of the plurality of side edges; and a plurality of liners (54, 56) defining respective widths that are less than the width of the single strip of adhesive material positioned closely adjacent to one another over the single strip of adhesive material.

The preamble phrase "printable media" is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause.

11. A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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12. Claim 17 is rejected under 35 U.S.C. 102(a) as being anticipated by Rudin (US006187405B1).

Rudin relates to an article (figure-9) comprising a sheet defining a front side, a rear side and at least first and second (74, 74) intersecting side edges, each of the first and second side edges defining opposing longitudinal ends, one of longitudinal ends of each of the first and second side edges defining a common longitudinal end (upper left hand corner shows a common end); a first strip of adhesive material (figure-10, 76) on one of the front and rear sides of the sheet adjacent to the first side edge and extending substantially from one longitudinal end of the first side edge to the other longitudinal end of the first side edge; a second strip of adhesive material (figure-10, 76) on the one of the front and rear sides of the sheet adjacent to the second side edge and extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge; first and second liners (74, 74 in figure-9) respectively covering the first and second strips of adhesive material; and a liner corner member (upper left hand corner in figure-9) adjacent to the common longitudinal end of the first and second side edges.

The preamble phrase "printable media" is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3,11, 15, 22, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroll.

Kroll, as discussed above fails to teach that the at least substantially opaque sheet comprises an 8 ½ inch x 11 inch sheet. It would have been obvious matter of design to modify Kroll by providing the sheet to have a size of 8.5x11 inches, because it would have involved a change in the size of the sheet. A change in size is found to be within the level of one of ordinary skill in the art.

As for claim 15, figure-1 shows common longitudinal end. However, Kroll fails to teach that the liner has mitered ends adjacent to the common end. It would have been obvious to one having ordinary skill in the art to modify Kroll by providing mitered ends shape to the liners for facilitating the removability thereof. A change of shape is found to be within the level of one of ordinary skill in the art.

Claims 24-26, have been addressed elsewhere hereinabove.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-

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1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Nasser Ahmad 2/17/07
Primary Examiner
Art Unit 1772

N. Ahmad.
February 18, 2007.


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2/20/07